REMARKS

Claims 22-70 are pending in the Application and all were rejected in the Office action mailed October 5, 2009. No claims are amended by this response, nor were any claims amended by the prior response. Claims 22, 37, 49, and 56 are independent claims. Claims 23-36, 38-48, 50-55, and 57-70 depend, respectively, from claims 22, 37, 49, and 56. Applicants respectfully request reconsideration of pending claims 22-70, in view of the remarks set forth below.

Amendments to the Specification

The section titled "CROSS REFERENCE TO RELATED APPLICATIONS" that begins on page 1 of the Application has been updated. Applicants respectfully submit that these amendments do not add new matter.

Claim Rejections

Claims 22-70 were rejected under 35 U.S.C. §103(a) as being unpatentable over Meyerson, *et al.* (US 5,579,487, hereinafter "Meyerson") in view of Morris, *et al.* (US 4,884,132, hereinafter "Morris"), in further view of Kotani (US 4,847,891). Applicants respectfully traverse the rejection.

Applicants respectfully note that all claims are rejected for reasons of obviousness. Applicants first review the requirements for a rejection based on obviousness. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on

obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

As noted in the Manual of Patent Examining Procedure (Revision 7, July 2008), "[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." (emphasis added) *See* MPEP at 2143.03. Further, "'**[a]ll** words in a claim must be considered in judging the patentability of that claim against the prior art.' *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA)." (emphasis added) *Id.*

Thus, the law is clear that words of a claim cannot be merely disregarded during examination. Instead, all the words in a claim must be considered during the examination process.

Applicants again respectfully note that no claims have been amended in this or the prior response. Therefore, Applicants respectfully submit that no new issues have been introduced that would necessitate a new search. Applicants respectfully submit that the claims in the Application are allowable over the cited art for the reasons previously set forth during prosecution, and those that appear below.

I. The Proposed Combination Of Meyerson, Morris, And Kotani Does Not Render Claims 22-70 Unpatentable

With regards to independent claims 22, 37, 49, and 56, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness, in that the proposed combination of references fails to teach, suggest, or disclose, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in claims 22, 37, 49, and 56. Applicants respectfully

maintain that the Office has again failed to show where the cited art teaches all of the features of Applicants' claim 22, 37, 49, and 56.

In addition, the Office has again failed to provide a "...clear articulation of the reason(s) why the claimed invention would have been obvious..." and "...some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness...", recognized by MPEP §2142 as necessary in establishing a *prima facie* case of obviousness. The Office fails to explain how the cited teachings are combined to render the subject matter of Applicants' claims. Applicants respectfully submit that the rejections of the instant Office action do not meet all of the requirements of MPEP §2142, do not establish a *prima facie* case of obviousness, and therefore do not render the claims of the Application unpatentable.

Applicants appreciate recognition by the Office that Meyerson fails to disclose "...using the wireless communication interface for transmitting image; and a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data...." *See* Office action at page 3.

In an attempt to overcome the admitted shortcomings of Meyerson, the Office turns to Morris and asserts that Morris teaches "...an image being processed and transmitted over a cellular network (column 1, lines 35-39); and selecting a path automatically to be used by the device to wirelessly communicate the image data (column 1, lines 35-68, processed image data and/or speech data are transmitted wirelessly)." *Id.* at page 3. Applicants respectfully disagree with what Morris is alleged to teach.

Applicants respectfully note that the Office again cites Morris only at column 1, lines 35-39 and 35-68 in support of the contention that Morris remedies the admitted shortcomings of Meyerson. Applicants first review Morris at column 1, lines 21-43, shown below in context and underlined, which recites:

> The personal security system transmits a picture of an object, such as a criminal suspect, and the identification of a portable transmitter, such as the social security number of the user, to a receiver at a remote location. Time of transmission is recorded. If a crime occurs, the time, picture of the suspect, and identification of the victim are obtained from a recorder at the receiver. A potential victim of a crime points his portable personal security unit at a criminal suspect and presses an activating switch. The unit senses available light on the object and provides a flash if required. At the same time focusing an aperture control is performed and an image of the object is admitted to an image recorder which is a focal plane sensor array. Image data from the focal plane sensor array is processed in an image data processor and the processed image data is fed to a cellular communication transmitter for transmitting to the remote receiving station. An audio pickup at the portable unit is connected to the receiver for transmitting voice communications over the transmitter. By pointing the device at a suspect and pressing a button, a person makes a permanent record of an image.

(underline added)

Applicants again respectfully submit that the cited portion of Morris shown above simply teaches that a "personal security unit" is used to capture and transmit an image of a suspected criminal, time information, and audio via a cellular communication transmitter to a remote receiving station. The cited portion of Morris does not however, teach or suggest at least what is asserted by the Office, namely, "...wherein a path used by the device to wirelessly communicate data is automatically selected", as recited by claims 22, 37, 49, and 56. Applicants respectfully maintain that the cited portion of Morris fails to make any mention of, for example, selecting a communication path. Applicants have previously presented this argument, which has gone unanswered by the Office. *See* response filed November 5, 2008 at pages 14-15.

Applicants again respectfully submit that the word "select" may be defined as "...to choose (as by fitness or excellence) from a number or group: to pick out...." See Merriam-Webster's Collegiate Dictionary, Tenth Edition, Merriam-Webster Incorporated,

2002, page 1056. Applicants respectfully submit that Morris does not perform a selection of a path, in that Morris discloses only one path, and merely uses the only path available. The Office has again failed to provide any explanation or interpretation of the reference to explain how Morris teaches or suggests selecting from one available path. Automatically using the only path available does not teach or suggest choosing from a number or group, in accordance with the language "automatically selected from a plurality of communication paths", as recited in Applicants' claims 22, 37, 49, and 56.

Instead, Morris teaches that the image data, the time, and audio information are transmitted only via a cellular communication transmitter to a remote receiving station. Morris fails to teach anything with respect to any other paths, and certainly does not teach the availability of "a number or group" of paths from which to choose, in accordance with the language of claims 22, 37, 49, and 56. Therefore, Applicants again respectfully submit that the portion of Morris shown above does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

Applicants now turn to the cited portion of Morris at column 1, lines 44-47, which states:

> A preferred personal security system has a hand-held unit having a digital image sensor and transmitter for transmitting a digital image and digital information to a remote location.

Applicants respectfully maintain that the portion of Morris shown above simply teaches that the "personal security unit" preferably is a handheld unit with a digital image sensor and a transmitter for transmitting a digital image to a remote location. Applicants respectfully submit, however, that the cited portion of Morris does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...", as recited by claims 22, 37, 49, and 56. Again, the cited portion of Morris fails to say anything about the availability of "a number or group" of paths from which to choose, and therefore does not teach selection of a communication path, in accordance with Applicants' claims 22, 37, 49, and 56.

Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

The Applicants' now address the portion of Morris, at column 1, lines 48-50, which states:

> The preferred personal security system further has an aperture optically aligned with the sensor for permitting an image to pass through to the sensor.

While the portion of Morris shown above does state that the "personal security system" of Morris preferably has an aperture optically aligned so as to permit an image to pass to a sensor, this portion of Morris, specifically identified by the Office, also fails to teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...", as recited by claims 22, 37, 49, and 56. The portion shown above fails to say anything about selection of a communication path, or to mention path selection, in accordance with Applicants' claims 22, 37, and 49. The cited portion of Morris does not teach of "a number or group" of communication paths from which to choose. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

Applicants now address the cited portion of Morris at column 1, lines 51-53, which states:

> Preferably, the hand-held unit includes a cellular transmitter and the image sensor is a surface image to digital signal conversion chip.

Applicants respectfully submit that this portion of Morris clearly teaches that Morris has identified cellular communication as the preferred mode, and that the image sensor is preferably "a surface image to digital signal conversion chip." This cited

portion of Morris, specifically identified by the Office, does not, however, make any mention of any other communication paths other than cellular communication, nor does it teach choosing from "a number or group" of communication paths. Accordingly, it necessarily does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...", as recited by claims 22, 37, 49, and 56. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

The Applicants' continue with Morris, at column 1, lines 54-64, which states:

> The preferred hand-held unit comprises a start button, a master control function unit connected to the start button, and an electronic power source, an illumination unit, a light sensor unit, a projection lens control unit, an aperture control unit, an image recording unit having a focal plane sensor array, an image processing unit connected to the image recording unit and a cellular communication unit. All of the units are connected to the master control unit and connected to the image processing unit for broadcasting signals from the image processing unit to a distant cellular receiving station.

The portion of Morris shown above merely describes the various elements of the "personal security system" of Morris. Again, this passage from Morris identifies the use of cellular communication for the communication of image signals to a distant receiving station. This portion of Morris, specifically identified by the Office, does not, however, teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...," as recited by claims 22, 37, 49, and 56. Once again, the cited portion fails to say anything about the availability of "a number or group" of communication paths or alternatives, or about selection of a communication path from such a group, in accordance with Applicants' claims 22, 37, 49, and 56. Therefore, Applicants respectfully maintain that the portion of Morris shown above also

does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

Finally, Applicants address the portion of Morris at column 1, lines 65-68, which states:

> The preferred personal security system further comprises an audio recording unit connected to the cellular communication unit for providing a digital audio signal to the cellular communication unit.

Applicants again respectfully submit that the portion of Morris shown above teaches that the "personal security system" of Morris preferably has an audio recording unit connected to provide a digital audio signal to a cellular communication unit. As is clearly stated, Morris again identifies **only** cellular communication for use in communicating information from the "personal security system" to a distant receiving station. This last portion of Morris, however, which was specifically identified by the Office, does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...", as recited by claims 22, 37, 49, and 56. The cited portion of Morris fails to say anything about "a number or group" of communication path from which to choose, or about selection of a communication path from such alternatives, in accordance with Applicants' claims 22, 37, 49, and 56. Therefore, Applicants respectfully maintain that the portion of Morris shown above also does not teach or suggest at least these aspects of Applicants' claims 22, 37, 49, and 56.

Applicants respectfully maintain that, for at least the reasons set forth above, Morris fails to teach or suggest what is asserted by the Office, namely, Applicants' feature "...wherein a path used by the device to wirelessly communicate data is automatically selected...", as recited by claims 22, 37, 49, and 56.

In its effort to overcome the deficiencies of Meyerson, the Office action also turns to Kotani stating at page 3, "Kotani teaches selecting a path from a plurality of

communication paths based upon a type of data being communicated wherein the type of data is one or both of processed data and/or speed [sic] data (Fig. 3A," "image transmission" for transmitting image data; Fig. 3B, "voice message output" for transmitting speed [sic] data)." *See id.* at page 3.

As an initial matter, Applicants respectfully note that the Office fails to make any reference to the text of Kotani in support of its assertions. Further, the Office does not provide any explanation or interpretation of Fig. 3A and Fig. 3B of Kotani, to explain how and why Fig. 3A and Fig. 3B teach what is asserted. The Office provides only the conclusory statement that "Kotani teaches...," which is insufficient to support a finding of obviousness. Applicants respectfully submit that MPEP §2142 recognizes that "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit," and further, that the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (emphasis added) The Office has not provided at least the "explicit analysis" and the "articulated reasoning" required to support a *prima facie* case of obviousness. Therefore, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness with respect to claims 22, 37, 49, and 56, and that claims 22, 37, 49, and 56, and any claims that depend therefrom, are allowable over the cited art for at least this reason alone.

In addition, Applicants have reviewed the cited portions of Kotani at Fig. 3A and Fig. 3B and have been unable to discern where Fig. 3A and Fig. 3B teach the missing elements of Applicants' claims 22, 37, 49, and 56. The Office offers only the vague statement regarding ""image transmission" for transmitting image data," and ""voice message output" for transmitting speed [sic] data." The Office fails to explain how Fig 3A and Fig. 3B, or these vague statements teach or suggest the missing aspects of Applicants' claimed feature "a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of

data being communicated." In the absence of direction from the Office, Applicants now turn to Kotani at col. 3, lines 6-68, which address Fig. 3A and Fig. 3B, beginning with lines 6-36, which state:

> FIGS. 3A and 3B comprise a pair of flow-charts showing the operation procedure of the system by the system control circuit 11.
>
> The sender selects, first, the telephone numbers of the persons in charge to be notified of the facsimile transmission-destination from among the second called-station telephone numbers stored in the dial-number storing apparatus 21, and sets them. Then, the telephone number of the other facsimile apparatus 4, the first called station which should transmit the image data is inputted by the telephone 8 on the side of the transmitter. The inputted telephone-number information is fed to the exchange machine 9 on the side of the transmission through the net control apparatus 7 to open the circuit with the exchange machine 10 on the side of the transmission so that the facsimile apparatus 1 is connected with the facsimile apparatus 4 on the side of the reception. At this time, the facsimile apparatus 4 on the side of the reception transmits, for example, tone signals of 2100 Hz back to the facsimile apparatus 1 on the side of the transmission to notify that the called station is the facsimile terminal. When the transmitting person gives the transmission order through the reception of the tone signal, the image data is accumulated in the data storing apparatus 13 after the image reading of the manuscript by the image reading apparatus 12, the photoelectric conversion, the binary conversion and so on. It is fed into modem 15 after data compression by the coding circuit 14, and is coupled into the circuit through the transmission filter 6 and the net control apparatus 7.

The portion of Kotani shown above teaches that a user at the sending end of a facsimile transmission selects the telephone numbers to be notified of the transmission, and that a phone number of the fax machine of the first recipient is inputted using a telephone. A telephone network connection is then established from "facsimile apparatus 1" to "facsimile apparatus 4" through "exchange machine 9" and "exchange machine 10." Upon connection, the "facsimile apparatus 4" then transmits tone signals

back to the "facsimile apparatus 1." Upon reception of the "tone signals," the user at the "facsimile apparatus 1" gives the transmission order, the "manuscript" is read, and image data is accumulated, converted, and transmitted via "modem 15" to "facsimile apparatus 4." Thus, Kotani teaches that a user selects telephone numbers which are to be notified after transmission of a "manuscript." The transmission of the "manuscript" is initiated by a user by inputting the telephone number of the receiving facsimile apparatus ("facsimile apparatus 4") using a "telephone 8."

Applicants respectfully submit that as shown in the above portion of Kotani, the telephone number of the receiving "facsimile apparatus" was also inputted by a user, and numbers to be dialed after facsimile transmission to notify recipients were selected and entered by a user. Thus, the system uses the numbers selected and supplied by the user for the purpose for which they were provided (*i.e.*, for either facsimile transmission, or notification). The Office does not provide any explanation or interpretation of Kotani to illustrate how Kotani teaches selection based on type of data being communicated, as more fully recited by claims 22, 37, 49, and 56. Therefore, Applicants respectfully submit that Kotani teaches that the user selects the path for the facsimile transmission by dialing the number of the "facsimile apparatus 4" on the "telephone 8," and by selecting and entering the numbers for the notifications, and does not teach or suggest "selecting a path from a plurality of communication paths based upon a type of data being communicated," as asserted by the Office. Applicants now review the portion of Kotani at col. 3, lines 37-68, which recites:

> The facsimile apparatus 4 on the side of the reception sequentially records the image data the signals as it is received by the decoding circuit and the image record apparatus.
>
> After such image data transmission as described hereinabove is finished, namely, the reading of the manuscript is completed the facsimile apparatus 1 on the side of the transmission transmits the DCN or disconnect signals to notify a facsimile apparatus 4 on the reception side of the facsimile transmission completion to close the facsimile circuit. After the DCN signal has been transmitted, the second called station telephone-number information

> initially stored in the dial number buffer 22 is fed into the automatic dial apparatus 23 to transmit the dial number in accordance with the information through the net controlling circuit 7 so as to open the circuit with the corresponding telephone 5 by each of the exchange machines 9, 10. After the polarity inversion detection (confirmation of the other-party response) of the circuit, the voice data previously stored through the microphone 31 in the voice data storing apparatus 33 are fed under the control of the voice control circuit 35. Voice messages of, for example, "This is ABC company. We have just sent a facsimile transmission, will you please confirm it?"; "This is Mr. Smith. We have sent you a facsimile transmission, will you please go and retrieve it at once?" or the like transmitted to the circuit through the transmission filter 6, the net control apparatus 7 to output them to the second called station telephone 5. And when the output of the message is completed, the second calling circuit is cut off to complete the transmitting operation.

The portion of Kotani shown above simply teaches that the "facsimile apparatus 1" transmits the facsimile transmission to "facsimile apparatus 4," and when finished, sends a "disconnect." The stored number(s) of the notification recipients, selected and entered by the user, are then used to dial the "telephone 5" of the notification recipient(s), and an audio voice message is played when the dialed recipient answers. When the voice message is finished, the "facsimile apparatus 1" disconnects from the telephone line. Applicants respectfully submit, however, that the Office has not shown how Kotani teaches or suggests, at least, "selecting a path from a plurality of communication paths based upon a type of data being communicated," as asserted by the Office. Applicants respectfully submit that the telephone number to which the facsimile is transmitted is selected and dialed into "telephone 8" by a user. Further, the telephone numbers for the "telephone 5" of the notification recipient(s) are selected and entered by a user. Applicants respectfully submit that the paths of each of the calls are selected by a user when selecting the telephone numbers of the "facsimile apparatus 4" and "telephone 5," that Kotani does not teach selecting the numbers based on the type of data to be communicated, and that the Office has not explained how the alleged teachings of Fig. 3A and Fig. 3B, set forth by the portion of Kotani shown above, teach

or suggest these features, as required by Applicants' claims 22, 37, 49, and 56. For at least these reasons, Applicants respectfully submit that Kotani also does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected...," as required by claims 22, 37, 49, and 56.

Therefore, Applicants respectfully submit that Office has not shown how and why the proposed combination of Meyerson, Morris, and Kotani teaches all aspects of Applicants' claims 22, 37, 49, and 56, as required by MPEP §2142 and §2143.03, that a *prima facie* case of obviousness has not been established, that the cited art does not render claims 22, 37, 49, and 56 unpatentable, and that claims 22, 36, 49, and 56, and any claims that depend therefrom, are allowable over the proposed combination of Meyerson, Morris, and Kotani.

With regard to dependent claims 28, 47, and 62, the Office action asserts Official Notice and alleges, without any supporting evidence, that "...the use of speech communication in cellular network is well known in the art." *See* Office action at page 4. Although a "speech communication in cellular network" may have been well-known in the art, Applicants respectfully challenge the conclusory assertions made in the Office action without any supporting evidence that the elements recited in dependent claims 28, 47, and 62 are well known or obvious in the art, in their respective contexts of independent claims 22, 37, and 56. Applicants respectfully submit that the elements recited in claims 28, 47, and 62 are not well known or obvious in their respective contexts. Applicants respectfully submit that, for example, in the context of the elements as recited in independent claims 22, 37, and 56, the elements in dependent claims 28, 47, and 62 are not well known or obvious. MPEP §2144.03(E) states that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Accordingly, in order to maintain the rejection, Applicants respectfully request that the Examiner produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific

factual statements and explanations to support the finding. See, e.g., MPEP §2144.03 and 37 CFR §1.104(d)(2). Applicants respectfully submit that in the absence of such support, the Office has failed to show that Meyerson teaches or suggests at least this aspect of Applicants' claims 28, 47, and 62. Because the Office only cites Meyerson, the Office has failed to show that the proposed combination renders claims 28, 47, and 62 unpatentable.

With regards to dependent claims 31-33, 45, and 65-67, the Office action asserts Official Notice and alleges, without any supporting evidence, that "...local area network, packet network, and TCP/IP network are all well known in the art." *See* Office action at page 5. Although a "local area network, packet network, and TCP/IP network" may have been well-known in the art, Applicants respectfully challenge the conclusory assertions made in the Office action without any supporting evidence that the elements recited in dependent claims 31-33, 45, and 65-67 are well known or obvious in the art, in their respective contexts of independent claims 22, 37, and 56. Applicants respectfully submit that the elements recited in claims 31-33, 45, and 65-67 are not well known or obvious in their respective contexts. Applicants respectfully submit that, for example, in the context of the elements as recited in independent claims 22, 37, and 56, the elements in dependent claims 31-33, 45, and 65-67 are not well known or obvious. MPEP §2144.03(E) states that "[i]t is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was based." Accordingly, in order to maintain the rejection, Applicants respectfully request that the Examiner produce references in support of the Examiner's contention or, if the Examiner is relying upon personal knowledge to support the finding of what is known in the art, then the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding. See, e.g., MPEP §2144.03 and 37 CFR §1.104(d)(2). Applicants respectfully submit that in the absence of such support, the Office has failed to show that Meyerson teaches or suggests at least this aspect of Applicants' claims 31-33, 45, and 65-67.

Because the Office only cites Meyerson, the Office has failed to show that the proposed combination renders claims 31-33, 45, and 65-67 unpatentable.

With regard to claims 36 and 70, the Office asserts that Meyerson discloses "...that a character recognition process (column 9, line 28, a bar code scanner does character recognition)." *See* Office action at page 6. Applicants have previously addressed this rejection, to which the Office has not responded. *See* response filed November 5, 2008. Applicants respectfully disagree with the assertion of the Office, and respectfully submit that the Office has failed to show any basis for the conclusory statement that "...a bar code scanner does character recognition." Applicants respectfully submit that by this statement, the Office is impliedly asserting that it is inherent that a bar code scanner recognizes characters.

According to MPEP §2112, Sec. IV, page 2100-47, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" (emphasis added)

The MPEP also states, "'In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.' *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)." MPEP §2112, Sec. IV, 2100-48 (emphasis in original).

The Office has failed to show that the "bar code scanner" of Meyerson necessarily performs character recognition. Therefore, Applicants respectfully submit that the Office has failed to show that Meyerson at column 9, line 28 renders Applicants' claims 36 and 70 unpatentable. Because the Office cites only Meyerson, Applicants respectfully submit that the Office has failed to show that the proposed combination of references renders claims 36 and 70 unpatentable.

Based at least upon the above, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness with respect to at least claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 in accordance with MPEP §2142, and has therefore failed to show that the proposed combination of Meyerson, Morris, and Kotani renders Applicants claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 unpatentable. Therefore, Applicants respectfully submit that the rejection of independent claims 22, 37, 49, and 56, and their respective dependent claims under 35 U.S.C. §103(a), cannot be maintained.

Therefore, for at least the reasons set forth above, Applicants believe that claims 22, 28, 31-33, 36, 37, 45, 47, 49, 56, 62, 65-67, and 70 are allowable. Applicants respectfully submit that claims 23-36, 38-48, 50-55, and 57-70 depend, respectively, from allowable independent claims 22, 37, 49, and 56. Because claims 23-36, 38-48, 50-55, and 57-70 depend from claims 22, 37, 49, and 56, Applicants respectfully submit that claims 23-36, 38-48, 50-55, and 57-70 are also allowable, for at least the same reasons. In addition, Applicants respectfully submit that claims 28, 31-33, 36, 45, 47, 62, 65-67, and 70 have been shown to be independently allowable. Therefore, Applicants respectfully request that the rejection of claims 22-70 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-70 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above. Applicants respectfully request that Examiner contact the undersigned at the number shown below, should the Examiner have any questions or if Applicants can be of any assistance.

The Commissioner is hereby authorized to charge any fees required by this submission, or to refund any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: January 5, 2010

By /Kevin E. Borg/
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